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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,897	04/12/2001	Kenichi Ueyama	205733US0	1680

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 12/08/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,897

Applicant(s)

UEYAMA ET AL.

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8 and 11-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-8, and 11-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Amendment C received on September 29, 2003 is acknowledged. Claims **1-5, 7-8, and 11-23** are pending in this application.

Response to Arguments

Applicant's arguments with respect to claims 1-5, 7-8, and 11-23 have been considered but are moot in view of the new ground(s) of rejection based on the amendments of September 29, 2003.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 7-8, 11, 13, 15-16, 20-21, and 23 are rejected under 35

U.S.C. 102(a) (e) as being anticipated by Reid et al (5,972,987).

Reid et al disclose a method of removing nits from the hair. The composition contains 50% dimethyl ether, 16.67% isobutene, 30.8% ethanol, 1.5% PVA/VA copolymer, 0.40% isopropyl myristate (oil agent), 0.40% perfume oil, 0.13% silicone (oil agent) and 0.30% eosin. The composition is applied to dry hair and allowed to left on

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the hair for 30 seconds to 5 minutes. The nits are removed and then the hair is shampooed. See column 7 to column 8, lines 12 and example 1.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sturla (5,551,453).

Sturla disclose an oil-based composition for the hair containing 3% maize-germ oil, 0.1% perfume, and 96.9% ethanol.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 7-8, and 11-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergmann et al (6,274,128) in view of Hulett et al (4,459,471).

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Bergmann et al teach an anhydrous self-warming composition to condition the hair. The composition contains 50.45% PEG 200, 2.5% cetearyl alcohol, 1% steareth-2, 1% steareth-21, 18.6% glycerin, and 3% dimethicone, among other components. See example 2. The composition may be applied to wet or dry hair and if the conditioner is a washout type, it is rinsed from the hair. The self-warming conditioner increases in temperature up to a 17-Celsius increase. See column 7, lines 14-17. Polar solvents such as methanol, ethanol, etc are taught on column 4, lines 1-5. Conditioner such as silicones, cationic polymers, hydrocarbons, fatty alcohols, either alone or in a combination are taught on column 4, lines 8-14. Paraffin wax or mineral oil is taught on column 4, line 57. Capric triglycerides and isopropyl palmitate are taught on column 5, lines 1-10.

Bergmann does not specify the amount of time the composition is left in the hair.

Hulett et al teach an electrical heating cap for applying heat to the hair. The electrical thermostat maintains the desired temperature during the desired conditioning period. See abstract. The frequent use of hot rollers and electrical hair dryers tend to damage the hair, and require hair-conditioning products. These conditioners are applied to the damaged in a heat-controlled environment for a short period of time, usually about 30 minutes. See column 1, lines 5-15. The cap is held at 125 degrees Fahrenheit for a 30-minute conditioning period. See column 5, line 54.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Bergmann et al and Hulett et al and utilize a heating cap. One would be motivated to do so since Hulett teaches the state of

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the art for conditioning damaged hair, Hulett states that applying a conditioner to the hair and heating it with a cap for thirty minutes is known in the art. Further, one would expect similar results since Bergmann teach the composition works better with heat allowing the microporous material to adsorbs the hair shaft; thus although the composition is self-warming, the use of external heat would increase the benefit of the composition. Therefore, one would be motivated to add heat via a heating cap to condition damaged hair.

Lastly, it is deemed obvious to one of ordinary skill in the art to substitute one oily component with another oil component. One would be motivated to do so since these oil agents are conventionally utilized in the hair care industry and Bergmann provides guidance on suitable oil agents and clearly teaches combining different types of oily agents.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

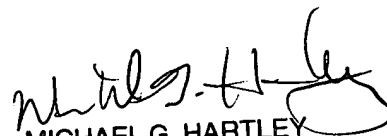
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is (703) 305-2147. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Sharmila S. Gollamudi


December 1, 2003


MICHAEL G. HARTLEY
PRIMARY EXAMINER